DAC

PATENT
Customer No. 22,852
Attorney Docket No. 01064.0011-04000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Richard LEVY	ATTN: Office of Petitions
Application No.: 09/357,957	Group Art Unit: 1714
Filed: July 21, 1999	Examiner: M. Medley
For: LUBRICANT COMPOSITIONS AND METHODS	

Commissioner for Patents
Box DAC
Washington, DC 20231

Sir:

PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. §1.181(a)

Appellant hereby petitions the Commissioner pursuant to 37 C.F.R. §1.181(a)(1) from an Action of the Examiner in the ex parte prosecution of this application, and to invoke the supervisory authority of the Commissioner pursuant to 37 C.F.R. §1.181(a)(3).

Appellant, after filing an appeal brief and receiving an Examiner's Answer, submits this Petition requesting that the Patent and Trademark Office reopen prosecution of the present application since the Examiner raised new grounds of rejection in her Answer, and then refused to enter an amendment to the claims that responded to the new rejection.

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Statement of Facts

The Examiner issued a Final Rejection in this application on December 19, 2001 which appellant responded to by way of a Notice of Appeal on January 2, 2002 and a Brief on Appeal filed March 1, 2002. The Examiner then filed an Examiner's Answer on May 22, 2002. Appellant responded to the Examiner's Answer on July 22, 2002 by filing a Reply Brief and a Rule 116 Amendment to address the new grounds of rejection. The Examiner's August 8, 2002 Communication advised the appellant that she would not enter the Rule 116 Amendment.

The Examiner's Answer

The Examiner's Answer lists the various grounds of rejection of the application, and includes a rejection of "claims 29, 35 and 42 . . . under 35 U.S.C. §102(b). . . Paper No. 10, dated July 5, 2001." (Examiner's Answer p. 4, lines 8-9). The July 5 Office Action applied Brannon-Peppas and Levy, United States Patent No. 4,985,251 to reject these claims under 35 U.S.C. §102(b).

In responding to Appellant's arguments regarding claims 29, 35 and 42 the Examiner argued "the fact that applicant [sic] has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." (Examiner's Answer, sentence bridging pp. 4 and 5) (emphasis added). The Examiner then cited Ex parte Obiaya, 227 U.S.P.Q. 58, 60 (Bd. Pat. App. & Int. 1985) to support her obviousness

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rejection. An analysis of Obiaya will show that the decision addressed a 35 U.S.C. § 103 obviousness rejection of the Obiaya claims.[1]

The Examiner goes on to find that "claims 29, 35 and 42 are anticipated by the teachings by Admitted Prior Art, Levy, 4,985,251 combined with Brannon-Pappas [sic, Peppas]," and finds "in response to applicant's [sic] arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Examiner's Answer, p. 5, first and second full paragraphs) (emphasis added) (citations omitted).

In summary, the Examiner repeatedly on pp. 4 and 5 of the Examiner's Answer addresses the claims as "obvious," combined the teachings of Brannon-Peppas and Levy to make the rejection, and argued the Appellant could not show "nonobviousness. . . where the rejections are based on combinations of references." Clearly, this illustrates the thrust of the Examiner's rejection of claims 29, 35 and 42 amounts to a new rejection on grounds of obviousness under 35 U.S.C. §103 and not the purported anticipation rejection under 35 U.S.C. § 102(b) of the final rejection.

A 35 U.S.C. §102 rejection, sometimes referred to as "anticipation," cannot employ multiple references since a "finding of anticipation requires that all aspects of the claimed invention were already described in a single reference. . . . If it is necessary to reach beyond the boundaries of a single reference to provide a missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but §103

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1 Importantly, the Examiner did not cite Obiaya in the July 5, 2001 Office Action.

obviousness." Scripps Clinic v. Genentech Inc, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991) (citations omitted) (emphasis added). Here the Examiner has employed the secondary references to supply elements lacking in the principle reference she relies on to make her rejection. Importantly, the Examiner's Answer repeatedly employs the criteria for obviousness in rejecting claims 29, 35 and 42 by combining the teachings of Brannon-Peppas and Levy, and attempting to rebut Appellant's distinctions of these references by finding that Appellant has attempted to show nonobviousness by attacking the references individually where the rejections are based on combinations of references.

The Examiner has made a new ground of rejection under 35 U.S.C. §103, and in response to this rejection, appellant is entitled to submit an amendment under 35 U.S.C. §1.116 to address the combination of teachings of Brannon-Peppas and Levy. Cf. 37 C.F.R. §1.193(a)(2) and (b)(2)(i).

Points To Be Reviewed

Appellant requests the Commissioner to determine whether or not the Examiner's Answer asserts a new ground of rejection of claims 29, 35 and 42 on grounds of obviousness under 35 U.S.C. § 103(a) whereas previously the Examiner rejected these claims under 35 U.S.C. §102(b) as anticipated by the various references.

Action Requested

Appellant requests that the Commissioner find that the Examiner did in fact issue a new ground of rejection in the Examiner's Answer and further request as relief that the

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Examiner formally reopen prosecution of the application and enter the attached Rule 116 Amendment responsive to the new grounds of rejection.

Conclusions

Appellant requests that the Commissioner grant the relief sought by this petition and any other relief the Commissioner may deem appropriate. If entry of this petition requires a fee not accounted for, appellant's attorneys request payment of any fees due from their Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: August 27, 2002

By: _____
Robert J. Eichelburg
Reg. No. 23,057

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